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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/789,000

02/26/2004

Thomas M. Mayers

3608

9213

45455 7590 08/19/2008  
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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

08/19/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/789,000	<b>Applicant(s)</b> MAYERS ET AL.	
	<b>Examiner</b> ALICIA CHEVALIER	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **RESPONSE TO AMENDMENT**

1. Claims 1-9 are pending in the application, claims 10-14 have been cancelled.
2. Amendments to the specification and claims, filed on May 13, 2008, have been entered in the above-identified application.

## ***NEW REJECTIONS***

3. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

## ***Claim Rejections - 35 USC § 103***

4. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baig (U.S. Patent No. 6,268,042) in view of Baig (U.S. Patent Application Publication No. 2002/0139611).

Baig '042 discloses a building panel (*col. 1, lines 15-24*) having a core made from a starch gel (*col. 3, lines 21-26*) and mineral wool fiber (*abstract*) composition, with the mineral wool fibers ranging from 17 to 25 weight percent of the core calculated on dry basis (*abstract*). Baig '042 does not explicitly disclose that the starch gel ranging from 75 to 83 weight percent of the core composition. However, where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges in weight percent of gel to fibers involves only routine skill in the art. MPEP 2144.05.

Baig '042 fails to disclose wherein the front surface of the tile is coated with aggregate particles.

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Baig '611 discloses a building panel (*title*) having a core (*fiber rich surface layer made of mineral wool fibers, paragraph 0021*) made from a starch gel (*starch binder of starch in the form of a gel, paragraph 0027*) and mineral wool fiber (*fiber rich surface layer made of mineral wool fibers, paragraph 0021*) composition, wherein the front surface of the tile is coated with aggregate particles (*calcium carbonate particle coating, paragraph 0061*). The aggregate particles are selected from the group consisting of calcium carbonate, crushed marble, sand, clay, perlite, vermiculite, crushed stone and glass and more specifically calcium carbonate (*paragraph 0061*). The building material has a noise reduction coefficient (NRC) value of at least about 0.50 (*paragraph 0062*).

Baig '611 further disclose that the particles are coarse (*paragraph 0061*). It is noted that Applicant defines coarse particles as to have a mean diameter of 2,500 microns (*specification page 9, lines 28-30*). Therefore, Baig '611 is deemed to disclose particles with a mean diameter of 2,500 microns.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add a layer of aggregate particles as taught by Baig '611 to Baig '042 in order to improve sound absorption.

The preamble "acoustical ceiling tile" is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

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The limitation “abuse-resistant” is a functional limitation and is deemed to be a latent property of the prior art since the prior art is substantially identical in composition and/or structure. MPEP 2145 (II).

The limitation “cast” is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

#### ***ANSWERS TO APPLICANT’S ARGUMENTS***

5. Applicant’s arguments in the response filed May 13, 2008 regarding the previous rejections of record have been considered but are moot due to the new grounds of rejection.

#### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Alicia Chevalier/  
Primary Examiner, Art Unit 1794  
8/19/2008